

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE  
PATENTING REJECTION OVER A PRIOR PATENT**

Docket No. 00-713-i-16

In Re Application of: Mirkin et al.

Application No.: 09/976,601

Filed: Oct. 12, 2001

For: Nanoparticles having oligonucleotides attached thereto and uses therefor

The owner\*, Nanosphere, Inc., of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 as shortened by any terminal disclaimer, of prior Patent No.6,506,564. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

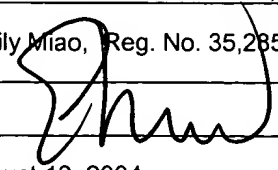
Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☐ The undersigned is an attorney or agent of record.

☐ Terminal disclaimer fee (\$ 55 – small entity ) under 37 CFR 1.20(d) is included.

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Date	August 12, 2004

\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).

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**APPENDIX A**

<b>ATTY Case No.</b>	<b>Serial No./ Filing Date</b>	<b>Inventors/Title</b>	<b>Status</b>
<b>00-653-G</b>	U.S. 10/794,741 Filed 3/5/04	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton, Garamella, Li, Park/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFORE	ALLOWED
<b>00-713-B1</b>	09/923,625 Filed 8/7/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFOR	ALLOWED
<b>00-713-C</b>	09/344,667, filed 6/25/99	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFORE	U.S. Patent No. 6,361,944, issued 3/26/02
<b>00-713-I</b>	U.S.S.N 09/603,830 Filed 6/26/00	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton; NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFOR	U.S. Patent No. 6,506,564, issued 1/14/03
<b>00-713-I-1</b>	09/961,949 9/20/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton;	U.S. Patent No. 6,582,921, issued June 24, 2003

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		NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFOR	
<b>00-713-I-2</b>	09/957,318 9/20/01	See 00-713-I-1	U.S. Patent No. 6,759,199, issued 7/6/04
<b>00-713-I-3</b>	09/957,313 9/20/01	See 00-713-I-1	U.S. Patent No. 6,645,721, issued 11/11/03
<b>00-713-I-4</b>	09/966,491 9/28/01	See 00-713-I-1	U.S. Patent No. 6,610,491, issued August 26, 2003
<b>00-713-I-5</b>	09/966,312 9/28/01	See 00-713-I-1	U.S. Patent No. 6,673,548, issued January 6, 2004
<b>00-713-I-6</b>	09/967,409 9/28/01	See 00-713-I-1	U.S. Patent No. 6,740,491, issued May 24, 2004
<b>00-713-I-7</b>	09/974,500 10/10/01	See 00-713-I-1	U.S. Patent No. 6,709,825, issued March 23, 2004
<b>00-713-I-8</b>	09/974,007 10/10/01	See 00-713-I-1	PENDING
<b>00-713-I-9</b>	09/973,638 10/10/01	See 00-713-I-1	ALLOWED
<b>00-713-I-10</b>	09/973,788 10/10/01	See 00-713-I-1	U.S. Patent No. 6,720,411, issued April 13, 2004
<b>00-713-I-11</b>	09/975,062 10/11/01	See 00-713-I-1	U.S. Patent No. 6,677,122, issued January 13, 2004
<b>00-713-I-12</b>	09/975,376 10/11/01	See 00-713-I-1	PENDING
<b>00-713-I-13</b>	09/975,384 10/11/01	See 00-713-I-1	PENDING

<b>ATTY Case No.</b>	<b>Serial No./ Filing Date</b>	<b>Inventors/Title</b>	<b>Status</b>
<b>00-713-I-14</b>	09/975,498 10/11/01	See 00-713-I-1	ALLOWED
<b>00-713-I-15</b>	09/975,059 11/11/01	See 00-713-I-1	ALLOWED
<b>00-713-I-16</b>	09/976,601 10/12/01	See 00-713-I-1	PENDING
<b>00-713-I-17</b>	09/976,968 10/12/01	See 00-713-I-1	ALLOWED
<b>00-713-I-18</b>	09/976,971 10/12/01	See 00-713-I-1	U.S. Patent No. 6,682,895, issued 1/27/04
<b>00-713-I-19</b>	09/976,863 10/12/01	See 00-713-I-1	PENDING
<b>00-713-I-20</b>	09/976,577 10/12/01	See 00-713-I-1	U.S. Patent No. 6,720,147, issued April 13, 2004
<b>00-713-I-21</b>	09/976,618 10/12/01	See 00-713-I-1	ALLOWED
<b>00-713-I-22</b>	09/981,344 10/15/01	See 00-713-I-1	U.S. Patent No. 6,777,186, issued August 17, 2004
<b>00-713-I-23</b>	09/976,900 10/12/01	See 00-713-I-1	PENDING
<b>00-713-I-24</b>	09/976,617 10/12/01	See 00-713-I-1	U.S. Patent No. 6,730,269, filed May 4, 2004
<b>00-713-I-25</b>	09/976,378 10/12/01	See 00-713-I-1	PENDING
<b>00-713-i-26</b>	10/410,324 04/10/03	See 00-713-I-1	PENDING
<b>00-713-L</b>	U.S.S.N. 09/693,005 Filed 10/20/00	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/	U.S. Patent No. 6,495,324, issued 12/17/02

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		NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERE TO AND USES THEREFORE	
<b>00-713-M</b>	U.S.S.N. 09/693,352 Filed 10/20/00	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERE TO AND USES THEREFORE	U.S. Patent No. 6,417,340, issued 7/9/02
<b>00-714-G</b>	U.S. 09/830,620 Filed 8/15/01	Mirkin, Nguyen/ NANOPARTICLES WITH POLYMER SHELLS	PENDING
<b>00-715-A</b>	U.S. 09/760,500 Filed 1/12/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton; Garamella, Li/ METHOD OF ATTACHING OLIGONUCLEOTI DES TO NANOPARTICLES AND PRODUCTS PRODUCED THEREBY	U.S. Patent No. 6,767,702, issued July 27, 2004
<b>00-715-B</b>	U.S. 10/716,829 Filed 11/18/03	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton; Garamella, Li/ METHOD OF ATTACHING OLIGONUCLEOTI DES TO NANOPARTICLES AND PRODUCTS PRODUCED THEREBY	Pending
<b>00-1085-A</b>	U.S.S.N.	Mirkin, Letsinger,	U.S. Patent No.

<b>ATTY Case No.</b>	<b>Serial No./ Filing Date</b>	<b>Inventors/Title</b>	<b>Status</b>
	09/820,279 Filed 3/28/01	etc./ METHOD AND MATERIALS FOR ASSAYING BIOLOGICAL MATERIALS	6,750,016, issued June 15, 2004
<b>00-1085-G</b>	U.S.S.N. 10/640,618 Filed 8/13/03	Mirkin, Letsinger, etc./ METHOD AND MATERIALS FOR ASSAYING BIOLOGICAL MATERIALS	Pending
<b>00-1086-A</b>	U.S. 09/903,461 Filed 7/11/01	Letsinger, Garimella/ METHOD OF DETECTION BY ENHANCEMENT OF SILVER STAINING	U.S. Patent No. 6,602,669, Filed 8/5/03
<b>00-1272-C</b>	U.S.S.N. 10/008,978 Filed 12/7/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton, Garimella, Li, Park, Lu/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERE TO AND USES THEREOF	PENDING
<b>01-565-A</b>	USSN 10/125,194 Filed 4/18/02	Mirkin, Nguyen, Watson, Park/ OLIGONUCLEOTI DE-MODIFIED ROMP POLYMERS AND CO- POLYMERS	PENDING
<b>01-599-A</b>	U.S.S.N. 10/291,291 Filed 11/08/02	Storhoff/NOVEL THIOL-BASED METHOD FOR ATTACHING OLIGONUCLEOTI DES TO NANOPARTICLES	PENDING
<b>01-661-A</b>	U.S.S.N. 10/034,451	Mirkin, Cao, Jin/ DNA-MODIFIED	PENDING

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	Filed 12/28/01	CORE-SHELL AG/AU NANOCRYSTALS	
<b>01-661-C</b>	U.S.S.N. 10/153,483 Filed 5/22/02	Mirkin, Cao, Jin/ DNA-MODIFIED CORE-SHELL AG/AU NANOCRYSTALS	PENDING
<b>01-661-E</b>	U.S.S.N. 10/397,579 3/26/03	Mirkin, Cao, Jin/ DNA-MODIFIED CORE-SHELL AG/AU NANOCRYSTALS	PENDING
<b>01-1565-A</b>	U.S.S.N. 10/266,983 Filed 10/08/02	Park, Taton, Mirkin/ARRAY- BASED ELECTRICAL DETECTION OF DNA USING NANOPARTICLE PROBES	PENDING
<b>01-1633-A</b>	U.S.S.N. 10/266,983 Filed 10/8/02	Park, Taton, Mirkin/NANOPARI CLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFOR	PENDING
<b>01-1705-A</b>	U.S.S.N. 10/108,211 Filed 3/27/02	Nam, Park, Mirkin/BIO- BARCODES BASED ON OLIGONUCLEOTI DE-MODIFIED NANOPARTICLES	PENDING
<b>02-338-B</b>	USSN 10/172,428 Filed 6/14/02	Cao, Jin, Nam, Mirkin/MULTI- CHANNEL DETECTION USING NANOPARTICLE PROBES WITH RAMAN SPECTROSCOPIC FINGERPRINTS	PENDING

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<b>02-338-C</b>	10/431,341 5/7/03	Cao, Jin, Nam, Mirkin/MULTICHAN- NEL DETECTION USING NANOPARTICLE PROBES WITH RAMAN SPECTROSCOPIC FINGERPRINTS	PENDING
<b>02-1227-A</b>	10/735,357 Filed 12/12/03	DIRECT SNP DETECTION WITH UNAMPLIFIED NUCLEIC ACID USING NANOPARTICLE PROBES	PENDING
<b>03-214-A</b>	10/789,831 Filed 2/27/04	LABEL-FREE GENE EXPRESSION PROFILING WITH UNIVERSAL NANOPARTICLE PROBES IN MICROARRAY ASSAY FORMAT	PENDING
<b>03-466-C</b>	10/854,848 Filed 5/27/04	METHOD FOR DETECTING ANALYTES BASED ON EVANESCENT ILLUMINATION AND SCATTER- BASED DETECTION OF NANOPARTICLE PROBE COMPLEXES	PENDING
<b>03-666-E</b>	10/877,750 Filed 6/25/04	BIOBARCODE	PENDING